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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,015	12/29/2003	Yong Chul Kim	060450.000010	8415
70416 7590 09/20/2007 THELEN REID BROWN RAYSMAN & STEINER LLP 2225 EAST BAYSHORE ROAD SUITE 210 PALO ALTO, CA 94303			EXAMINER ELVE, MARIA ALEXANDRA	
			ART UNIT 1725	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,015

Applicant(s)

KIM ET AL.

Examiner

M. Alexandra Elve

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed 8/1/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: i) "butt", ii) "manufactured by the method to a flux-unfilled wire", iii) "filling" and "filled" and iv) "unfilled".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 & 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claussen (USPN 3,418,446).

Claussen discloses a welding wire for gas shielded arc welding. The flux cored electrode is constructed from a hollow steel sheath, which is initially flat and then formed into a channel shape. The strip is then filled, butt welded and drawn down by dies. The content of the electrode is particulate or granular form. Optimum fill of the

electrode is 16% by weight; however, some wires are further filled with silica sand that is they are more greatly packed. The strength difference between the less packed and more packed (silica sand addition) is: 81/78 yielding a ratio of about 1.1.

Claussen does not teach the equation (1) in applicant's claim. The electrode disclosed by Claussen possesses all the properties applicant attributes to the electrode.

Although the prior art does not teach the equation claimed, it does disclose the electrode and the approximate ratio. It has been held that there is no invention in the discovery of a general formula if it covers a product described in the prior art. See In re Cooper et al. 57 USPQ 117.

The exact ratio, as taught by Applicant's claim is not disclosed in the prior art, however, the prior art closely approximates applicant's claimed ratio. It has been held that one of ordinary skill in the art at the time of the invention would have considered that ratio to be obvious because close approximation is considered to establish a prima facie case of obviousness. See In re Malagari 182 USPQ 549, Titanium Metals v. Banner 227 USPQ 773, In re Nehrenberg 126 USPQ 383.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (USPN 6,649,872).

Kato et al. discloses a flux cored electrode, which is constructed of a steel sheath formed into a U-shape, filled and drawn. Fill percentages are shown in table 4 and corresponding strengths in table 10. The maximum strength ratio is: 582/524 yielding a ratio of 1.1.

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Kato et al. does not teach the equation (1) in applicant's claim. The electrode disclosed by Kato et al. possesses all the properties applicant attributes to the electrode.

Although the prior art does not teach the equation claimed, it does disclose the electrode and the approximate ratio. It has been held that there is no invention in the discovery of a general formula if it covers a product described in the prior art. See In re Cooper et al. 57 USPQ 117.

The exact ratio, as taught by Applicant's claim is not disclosed in the prior art, however, the prior art closely approximates applicant's claimed ratio. It has been held that one of ordinary skill in the art at the time of the invention would have considered that ratio to be obvious because close approximation is considered to establish a prima facie case of obviousness. See In re Malagari 182 USPQ 549, Titanium Metals v. Banner 227 USPQ 773, In re Nehrenberg 126 USPQ 383.

The prior art discloses a product substantially similar to the claimed product, differing only in the manner by which it is produced. It has been held that one of ordinary skill in the art at the time of the invention would have considered the claimed compositions to be obvious because of the similarity in the properties and closely approximating ranges. The burden falls to the applicant to show that any process steps associated with the claimed product result in a materially different product from those of the prior art, because there is nothing in the record before the examiner to reasonably conclude that applicant's product differs in kind from those obtained by the reference. See In re Brown 173 USPQ 685 and In re Fessmann 180 USPQ 324.

Response to Amendment

The amendment filed 8/1/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: i) "butt", ii) "manufactured by the method to a flux-unfilled wire", iii) "filling" and "filled" and iv) "unfilled".

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed 8/1/07 have been fully considered but they are not persuasive.

Applicant argues that the flux cored wires of the references are different than that of instant claims because they are used for welding different materials. The examiner respectfully notes that intended use is not germane to determining patentability.

Applicant argues that tensile strengths of 78,000 and 81,000 (no units given) are not taught by Claussen. The examiner respectfully notes that these limitations are not disclosed in applicant's specification or initially submitted claims.

Applicant argues that Claussen teaches a filled fully wire. The examiner respectfully disagrees because less packed wires are taught by Claussen.

Applicant argues that the present invention improves rectilinear propagation and Claussen does not teach this. The examiner respectfully notes that this limitation is not

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stated in instant claims. Furthermore, if a composition is physically the same, it must have the same properties. A chemical composition and its properties are inseparable. Therefore the prior art teaches the same chemical composition, the properties of instant claims are necessarily present. See *In re Spada*, 15 USPQ 2d 1655, 1658.

Applicant argues that Claussen does not have the same chemical properties as instant invention. The examiner respectfully notes that no chemical property limitations are stated in the claims. Furthermore, if a composition is physically the same, it must have the same properties. A chemical composition and its properties are inseparable. Therefore the prior art teaches the same chemical composition, the properties of instant claims are necessarily present. See *In re Spada*, 15 USPQ 2d 1655, 1658.

Applicant argues that tensile strengths of 78,000 and 81,000 (no units given) are not taught by Kato et al. The examiner respectfully notes that these limitations are not disclosed in applicant's specification or initially submitted claims.

Applicant argues that Kato et al. does not have the same chemical or wire properties as instant invention. The examiner respectfully notes that no chemical property limitations are stated in the claims. Furthermore, if a composition is physically the same, it must have the same properties. A chemical composition and its properties are inseparable. Therefore the prior art teaches the same chemical composition, the properties of instant claims are necessarily present. See *In re Spada*, 15 USPQ 2d 1655, 1658.

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Applicant argues that Kato et al. does not teach "no butt of steel sheath". The examiner respectfully notes that "butt" is not stated in the initial specification or claims. This is a new matter issue.

Applicant argues that Kato et al. does not teach "flux-un-filled". The examiner respectfully notes that "flux-un-filled" is not stated in the initial specification or claims. This is a new matter issue.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 7:30-4:00 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on 571-272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 16, 2007.

/M. Alexandra Elve/
M. Alexandra Elve
Primary Examiner 1725